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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COZART, JERMIE E

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/623,865

Applicant(s)

PLANK, OTTO

Examiner

Jermie Cozart

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 2 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 2 recites the limitation "the feed movement" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 6 recites the limitation "the feed movement" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. Claims 1-3, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashby et al. in view of Bartelheim.

Regarding **claim 1**, Ashby discloses producing a rim hole (not labeled, see Figure 1A) through a stack of at least two metal plate-shaped work pieces (82,84) using a hole punch (54), driven vertically through the stack, wherein material (88) of one of the

plate-shaped work pieces (82), which faces the hole punch, is pushed through an opening (not labeled) of another rear plate-shaped work piece (84), where inside contours of the opening correspond to outer contours of a rim hole (not labeled, see Figure 1A). Ashby creates a penetration opening (not labeled, see Figure 5) through the stack (82,84), the penetration opening has a cross-section surface corresponding at most to a cross-sectional surface of the opening of the rim hole, and forms by movement of the hole punch (10) in a single feed direction, both the rim hole (*not labeled, see Figure 1A*) and the opening (*not labeled, see Figure 5*) in the rear plate-shaped work piece (84) seen from the direction of feed, by having the rear plate-shaped work piece (84) pointing away from hole punch supported by a matrix (74).

Regarding **claim 2**, Ashby discloses wherein at the end of the feed movement of the hole punch (54), the rim hole provides over the surface of rear plate-shaped work piece facing matrix (74). *See Figures 1A and 8 for further clarification.*

Regarding **claim 3**, Ashby discloses flanging the rim hole by means of a flange punch (64) fed from a side of the work pieces opposite the hole punch (54), whereby after flanging an outer surface of the rim rests at least in some sections on an outer surface of the rim hole. *See Figure 8 for further clarification.*

Regarding **claim 5**, Ashby discloses the penetration opening (not labeled, see Figure 5) being created through the stack with an essentially constant cross-section.

Regarding **claim 6**, Ashby discloses the penetration opening (not labeled, see Figure 5) being created with the feed movement of the hole punch (54) by means of the rim hole punch (54) and by which the rim hole (not labeled, see Figure 1A) is formed.

Ashby, however, does not disclose a rim hole punch, which breaks out when the rim hole punch is driven the stack, a piece of material of the rear plate-shaped work piece the outer contours of which piece of material correspond to the outer contours of the rim hole, or the piece of material being formed by the feed movement of the rim hole punch.

Bartelheim discloses a rim hole punch (10), which breaks out when the rim hole punch is driven the stack of work pieces (20, 21), a piece of material (28) of the rear plate-shaped work piece (20), the outer contours of which piece of material (28) correspond to the outer contours of a rim hole (26), and the piece of material (28) being formed by the feed movement of the rim hole punch (10). *See Figures 2-3, and columns 1 and 2 for further clarification.*

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a rim hole punch in place of the hole punch of Ashby which breaks out when the rim hole punch is driven the stack, a piece of material of the rear plate-shaped work piece the outer contours of which piece of material correspond to the outer contours of the rim hole, and wherein the piece of material is formed by the feed movement of the rim hole punch, in light of the teachings of Bartelheim, in order to provide a more effective way to assemble articles to one another.

Response to Arguments

7. Applicant's arguments filed 12/4/02 have been fully considered but they are not persuasive.

Applicant argues that Bartelheim relates non-analogous art to the present invention, and that a person of ordinary skill in the art to which Applicant's invention is directed would not look to Bartelheim, either alone or as a modification of Ashby, to render the obvious the Applicant's claim 1, as amended or the claims depending therefrom.

In response to applicant's argument that Bartelheim is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Bartelheim is clearly concerned with producing a rim hole through overlapping sheets of material.

Applicant also argues that neither Ashby nor Bartelheim, alone or combined in the proposed manner, disclose or suggest every limitation of Applicant's claim 1. Applicant further argues that Bartelheim does not disclose or suggest as recited in claim 1, that the outer contours of the piece of material removed from the rear plate-shaped work piece by the rim hole punch correspond the outer contours of the rim hole.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Ashby and Bartelheim are each directed to fastening overlapping sheets onto one another using a punch and die assembly. Bartelheim discloses a rim hole punch (10), which breaks out a piece of material (28) of the rear plate-shaped work piece (20), the outer contours of which correspond to the outer contours of a rim hole (26), as the rim hole punch (10) moves in the single feed direction. The disclosure of Bartelheim thereby provides an alternative way in which to effectively connect overlapping sheets to one another and thereby produce a rim hole. See *Figures 2-3, and columns 1 and 2 for further clarification*. Therefore, the modification of Ashby in light of the teachings of Bartelheim renders the claimed invention obvious.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

10. If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 703-305-0126. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
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If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http: www.uspto.gov


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JC 
February 19, 2003